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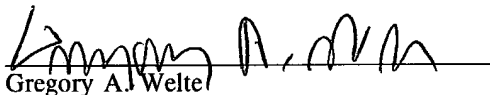
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Assignee's Docket No.: 7890)
Group Art Unit: 2662)
Serial No.: 09/229,046)
Examiner: S. Tsegaye)
Filing Date: January 12, 1999)
Title: Transaction Processing)
Systems Maintenance)

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CERTIFICATE OF MAILING

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Gregory A. Welte

REQUEST FOR RECONSIDERATION

Honorable Commissioner of Patents and Trademarks
Washington, DC 20232

Sir:

This Request is submitted in response to the Office Action mailed on April 22, 2004. Claims 1 - 147 are pending, and all stand rejected at present.

Applicant acknowledges the objection to the claims, and will rectify the situation as appropriate.

SUMMARY OF RESPONSE TO PRIOR-ART REJECTIONS

Because of a specific rule which applies to certain

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applications filed before a specific date, the Korman reference cannot be used as prior art.

The Korman reference was used to reject all claims, except a group of claims rejected based in Sisley. Applicant points out that Sisley shows a system for repairing equipment, in which owners of the equipment telephone a central station, to report malfunctions. Sisley then schedules repair technicians to visit the sites of the equipment, for repairs. The repair technicians may make contact with the central station, but by telephone.

Applicant points out that every claim in the group rejected based on Sisley contains one, or more, of the following recitations.

-- The service person's **computer** makes contact with another agency, to give notice that the service person will handle the problem.

-- Sisley does not show that: **telephone calls**, with humans speaking, are used. Also, in Sisley, the technician does not have the option of refusing an assignment. Therefore, there is no reason for the technician to give notice that he will handle an assignment.

-- The malfunction, called an "error" in some claims, occurs in a "transaction terminal." That same terminal is the entity contacted by the service person's terminal

in the previous paragraph. Restated, the service person's terminal contacts the "patient" who is to be repaired.

-- That does not occur in Sisley. The repair technicians contact the central station, not the equipment to be repaired, to acknowledge the problem, and the contact is not done as claimed.

-- Some claims all recite "launching an intelligent agent onto the network," or a similar recitation. The Specification, page 14, lines 15, 16, states:

Intelligent agents are a class of software consisting of code and data that can be transmitted around network computing environments.

-- Sisley does not show that. At best, he transfers data, not code.

-- Claim 113 states that "the transaction terminal . . . is notified when a servicing person's terminal is not longer operative on the network," for example, when the latter terminal logs off.

-- That is not found in Sisley. One reason is that, in Sisley, terminals appear **not** to be assigned to specific individuals.

-- Some claims state that the terminal-to-be-repaired

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notifies a central station, if repairs are not done in time.

-- Sisley does not show that. Again, the equipment to be repaired in Sisley does not contact the central station. The human owners make the contact.

Since every claim in this group contains at least one recitation which is absent from Sisley, the 102-rejections cannot stand. MPEP § 2131 states:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

END SUMMARY

RESPONSE TO REJECTIONS BASED ON KORMAN REFERENCE

Applicant points out that the Korman '887 reference is not available as prior art. Three dates are involved in Korman:

Korman's U.S. filing date of July 2, 1999,

Korman's PCT filing date of December 2, 1998, and

Korman's Provisional filing date of December 2, 1997 (one year prior to the PCT date.)

The earliest possible filing date available to Korman is his PCT filing date. Since Applicant's foreign priority date, namely, July 25, 1998, is prior to Korman's PCT filing date, Korman cannot

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be used as a reference. This will be explained.

The relevant rule is found in MPEP § 706.02(b), page 700-24, left column, second paragraph (Rev. 2, May, 2004). The rule is this:

No international filing dates prior to November 29, 2000, may be relied upon as a prior art date under 35 U.S.C. 102(e) . . .

This rule precludes use of Korman. The rule further prohibits use of the earliest date in Korman, namely, the provisional date:

Patents issued directly, or indirectly, from international applications filed before November 29, 2000, may only be used as prior art based on the provisions of 35 U.S.C. 102(e) in effect before November 29, 2000.

Thus, the 35 U.S.C. 102(e) date of such a prior art patent is the earliest of

the date of compliance with 35 U.S.C. 371(c)(1), (2), and (4),

or

the filing date of the later-filed U.S. continuing application that claimed the benefit of the international application.

In this rule, "the date of compliance with 35 U.S.C. 371(c)(1), (2), and (4)" refers to the completion of formal requirements for entry into the "national stage." Since the earliest possible date for that completion is the PCT filing date, the earliest effective date of Korman '887 is his PCT filing date.

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As stated above, Applicant's foreign priority date precedes that PCT date. Therefore, Korman is not available as prior art.

This conclusion is confirmed by the MPEP's EXAMPLE 6, found on page 700 - 33. In EXAMPLE 6, an International Application, IA, was filed in Canada on January 1, 2000, that is, prior to November 29, 2000. The MPEP states (last two paragraphs):

If the IA properly claimed priority/benefit to any earlier-filed U.S. application (whether provisional or nonprovisional)

. . . .

[then]

the 35 U.S.C. 102(e) date for the patent will still be 01 July 2002 (the date of fulfillment of the requirements under 35 U.S.C. 371(c) (i), (2), and (4)).

If a later-filed U.S. nonprovisional . . . application claimed the benefit of the IA in the example above, . . . the 35 U.S.C. 102(e) date of the patent of the later-filed U.S. application would be 01 July 2002 (the date that the earlier-filed IA fulfilled the requirements of 35 U.S.C. 371(c) (1), (2), and (4)).

Therefore, Applicant submits that EXAMPLE 6 is directly on-point. The filing date of the IA in EXAMPLE 6 corresponds to the PCT filing date of Korman. The MPEP, in EXAMPLE 6, states that no benefit of an earlier provisional is available.

Consequently, the earliest possible effective date of Korman is the PCT filing date. As stated above, Applicant's foreign

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priority date precedes that. Korman cannot be used as a reference.

RESPONSE TO PRIOR-ART REJECTIONS

Since Korman is not available as a reference, only the rejections which rely on other references must be addressed. Those rejections are the 103-rejections of claims 81 - 90, 99 - 105, 113 - 115, and 126 - 128, based on Sisley.

CLAIM 81

Claim 81 recites:

81. A system comprising
a networked transaction terminal element
and
two or more servicing persons' terminals
interconnected over a network,
in which the transaction terminal element
notifies one or more of the servicing persons'
terminals in the event of an error condition
within the transaction terminal element,
and
in which a servicing persons' terminal
notifies the transaction terminal element in
the event that the associated servicing person
accepts responsibility for servicing the error
condition.

Point 1

Applicant is unable to locate the **highlighted** passage in claim

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81 in Sisley, and requests, under 37 CFR §§ 1.104(c)(2) and 35 U.S.C. § 132, that the PTO specifically identify the claimed "notification," which is done by "a servicing person's terminal."

Applicant is aware that the Office Action asserts that Sisley, column 5, line 45 - column 6, line 41 shows the passage in question. However, that part of Sisley merely shows

- receiving telephone calls from customers who report malfunctions in equipment (column 5, lines 55, 56);
- selecting a technician who is suitable to handle each malfunction (column 5, bottom);
- scheduling a time for the technician to visit the site of the malfunction (column 6, top, and lines 16 - 24);
- various modifications which are induced by other types of incoming "calls" (column 6, lines 25 - 41.)

The PTO apparently treats the very last element of the four elements listed immediately above as the **highlighted** part of claim 81. However, claim 81 states that the "servicing person's **terminal**" performs the claimed notification. Sisley indicates that a technician makes reports using a **telephone**.

Thus, the claimed "servicing person's terminal" has not been shown in Sisley.

Point 2

The **highlighted** claim language states that the "servicing person's terminal" gives notice that the person accepts responsibility for servicing the error.

Applicant cannot locate such a notice, and requests that it be identified in Sisley. The undersigned attorney has examined Sisley, and interprets Sisley as showing a scheduling system, for scheduling tasks for technicians, the tasks being located at various geographic sites.

However, Sisley does not appear to give technicians any options for refusing an assigned task. Consistent with this, the undersigned attorney cannot find a discussion in Sisley of how re-scheduling is done, when a refusal occurs.

Further, Sisley repeatedly emphasizes how his scheduling system optimizes resources. Plainly, if a technician is allowed to refuse an assignment, optimization can be reduced. For example, assume that technician A can fix machine X in 2 hours, but every other technician requires 5 hours. Clearly, technician A will be assigned to machine X. But if technician A is allowed to refuse, then fixing machine X will take 3 hours longer. Optimality has been lost.

It is reasonable to assume that, if Sisley allowed such refusals, Sisley would discuss (1) the effect on optimality and

(2) how Sisley compensates for the reduction in optimality. But the undersigned attorney can find no such discussions in Sisley.

Therefore, claim 81 states that a technician gives notice of accepting responsibility for an error. If Sisley shows that, then it is reasonable to assume that Sisley would discuss events which ensue when a technician refuses an assignment. But, as just discussed, Sisley does not discuss that. Consequently, it is reasonable to assume that Sisley does not receive such notice, because it is not needed. Sisley's technicians have no choice.

Point 3.

Claim 81 states that the notice discusses in the **highlighted** passage is sent to "the transaction terminal," which is the **networked** "transaction terminal" previously recited. An ATM, Automated Teller Machine, provides an example of such a terminal. (See Specification, page 1, lines 10 - 14.)

Claim 81 also states that the "error" occurs in that same "transaction terminal." Thus, under the terms of claim 81,

- the ATM/terminal detects an error;
- the ATM/terminal notifies "servicing persons' terminals" of the error; and
- a servicing person's terminal responds to **the ATM/terminal**, and accepts responsibility.

That is not found in Sisley. The "error" does not occur in

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the system which schedules Sisley's technicians. Thus, even if a technician in Sisley agreed to accept responsibility as claims (which does not occur), that technician would not send notice to the system which is malfunctioning.

That would make no sense.

Point 4

The converse of point 3 applies. The claim states that the ATM/terminal notifies "servicing persons' terminals" of an "error" **within** the ATM/terminal. That is not found in Sisley.

As explained above, in Sisley, third persons telephone a central station about malfunctions at their sites. The central station then schedules technicians to handle the malfunctions.

The malfunctions do not occur at the central station in Sisley.

Claims 82 - 90

The discussion of claim 81 applies to these claims. Specifically, in these claims, the error occurs in the system which notifies the "service persons' terminals." As explained above, the malfunctions in Sisley do not occur in the system which schedules the technicians.

In addition, these claims all recite "launching an intelligent agent onto the network," or a similar recitation. The

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Specification, page 14, lines 15, 16, states:

Intelligent agents are a class of software consisting of code and data that can be transmitted around network computing environments.

Applicant cannot find transmission of "intelligent agents," as just defined, in the passages of Sisley cited to reject the claims, namely, column 5, line 45 - column 6, line 41. At that location in Sisley, only data transmission is discussed.

Claims 99 - 105

The discussion above applies to these claims. Specifically, these claims state that the error to be serviced occurs in the "transaction terminal" (eg, an ATM). They also state that the acknowledgement of the service persons are made to that same "transaction terminal."

In Sisley, the technicians do not send acknowledgement to the systems they are to repair.

And, as explained above, the technicians in Sisley do not send acknowledgements at all. They have no choice in whether to accept an assignment.

Claims 113 - 115

Claims 113 and 115 state that an agent-program is launched

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onto the network. As explained above, that is not found in Sisley.

Claim 113 states that the error occurs in the "transaction terminal." Thus, the "transaction terminal" both (1) experiences the error and (2) launches the agent-program. That is not found in Sisley.

Claim 113 states that "the transaction terminal . . . is notified when a servicing person's terminal is not longer operative on the network," for example, when the latter terminal logs off. That is not found in Sisley. One reason is that terminals assigned to specific technicians have not been identified.

Further, that would be inconsistent with Sisley's overall discussion. If a technician in Sisley logged off, and thus became unavailable, then Sisley could not schedule that agent for handling malfunctions. The undersigned attorney cannot find a discussion in Sisley which contemplates that possibility.

Claim 114 recites three elements: a "transaction terminal," "a central server," and "a service person's terminal." Those three elements have not been shown in Sisley.

Claim 114 further states:

. . . in which the transaction terminal element notifies the central server in the event a responsible service person fails to service an error condition within the transaction terminal element within an allotted period of time.

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The claimed notification has not been shown in Sisley.

Further, the claimed notification states that the "error condition" has not been serviced. That "error condition" occurs in the "transaction terminal." The "transaction terminal" sends the notice in question. That has not been shown in Sisley.

Claim 115 states that information about a device is transmitted, in response to a program launched onto a network. That has not been shown in Sisley.

Claims 126 - 128

Claim 126 recites:

126. A system comprising
a networked transaction terminal element,
a central server
and
a servicing person's terminal interconnected
over a network,

in which when the transaction terminal element
logs on to the network,

the transaction terminal element is notified
by the central server as to **the network
identity** of servicing persons potentially
available for servicing of the transaction
terminal element.

Claim 126 states that "the network identity" of "servicing persons" is transmitted to the "transaction terminal." "Network identity" means, inter alia, the network address, such as a web

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site or e-mail address.


That has not been shown in Sisley.

Conclusion

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,


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